

REMARKS

Reconsideration of the above-identified patent application as amended herein is respectfully requested. Claims 1-5 and 9-12 are cancelled herein and replaced by new claims 13-18. Of the claims, only claim 13 is independent.

IN THE SPECIFICATION:

In the Office Action of May 23, 2003, the Examiner objected to the specification for failing to provide proper antecedent support for the subject matter of claims 4-8. Claims 4-5 are cancelled herein and the specification is amended to provide support for the subject matter of claims 6-8. The support is provided at page 7, after the third full paragraph. In addition, the paragraphs beginning at page 1, line 10, and at page 2, line 3, respectively, are amended herein to correct typographical errors and to conform the name of the chemical elements to the current chemical nomenclature. No new matter has been added.

IN THE CLAIMS:

In the Office Action, the Examiner objected to claim 1 because of informalities. Claim 1 is cancelled herein and replaced by claim 13 to correct the informalities as required in the Office Action.

The Examiner also rejected claims 4-5 and 9-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicants regard as the invention. In addition, claims 9-12 were rejected under 35 U.S.C. 101 for claiming a use, without setting forth any steps involved in the process, and therefore resulting in an improper definition of a process.

Claims 4-5 and 9-12 are cancelled herein and replaced by new claims 15-18 which are drafted as apparatus claims and are therefore now directed to a patentable subject matter. The new claims were drafted to further clarify the invention and are now believed to overcome the rejections under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 101. Therefore, the withdrawal of these rejections is respectfully requested.

In the table below, the correspondence between new claims 13-18 and the original claims is shown.

Correspondence Table

Claim No.	Original Claim No.
13	1 + 3
14	2
15	9
16	10
17	11
18	12

In the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. 103(a) as being unpatentable over Kudo et al. Applicants respectfully traverse the rejection.

In order for the claims of the instant application to be obvious in light of the teachings of the cited reference:

“...there must be some suggestion or motivation, either in the [reference itself], or in the knowledge generally available to one of ordinary skill in the art, to modify the reference...[and]

...the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination...must be both found in the prior art.” (MPEP 706.02(j)).

Kudo et al. teach an alloy useful for manufacturing tubing and drill pipes for use in oil-well operations. Applicants assert that one of ordinary skill in the art would not find in the Kudo reference the suggestion or motivation to modify its teaching to arrive at the presently claimed invention. Kudo et al. do not teach or suggest all the limitations of claim 13 which corresponds to original claim 1 to which the limitations of original claim 3 have been added.

Claim 13, recites:

“...**a maximum content of 0.02% Ti;**

a content of 0.05-0.5 % Nb; ...

...a content of 0.05-0.5 Al;

...a content of 0.001-0.30 % Zr; and

Nb and Ta as needed,...wherein the total of Nb and Ta is at most 0.30, and wherein the maximum total of Al + Ti is 0.30%.”

Applicants point out that claims 1, 5, 9, 14 and 19 of the Kudo reference, which contain the essence of the invention described therein, teaches alloys which differ from the alloys claimed in claim 13.

For example, claim 1 of Kudo discloses that only the amounts of Ni, Cr and Fe overlap with the amounts claimed in claim 13. Further elements may be there, but they may also be omitted. In addition, claim 1 of Kudo does not disclose Nb, Al or Zr, claimed instead in claim 13 of the present invention.

Claim 5 of Kudo shows that one or more of Nb, Ti, Ta, and Zr are present in the total amount of 0.5-4 %, but is silent regarding the amount of Al. Thus, claim 5 of Kudo differs from claim 13 of the presently claimed invention.

Claim 9 of Kudo teaches an amount of N between 0.05 to 0.30 %. However, claim 9 of Kudo does not disclose Al, Nb, Ti, Ta and Zr. Claim 14 discloses that N, in the amount between 0.05 to 0.30 %, as well as one or more of Nb, Ti, Ta, Zr and V, shall be present in the range between 0.5 to 4 %, but does not disclose Al. Therefore, both claims 9 and 14 differ from claim 13 of the present invention and do not render it obvious.

Claim 19 of Kudo teaches that N may be present in the alloy in the amount between 0.05 to 0.3 %, as well as Nb and V in the ranges between 0.5 to 4 %, but does

not disclose Al. Thus, claim 19 of Kudo teaches alloys of different composition from the alloys of claim 13 of the present invention.

Therefore, for the reason set forth above, the alloys disclosed in Kudo are different from the alloys claimed in the presently claimed invention, and a person of ordinary skill in the art would not arrive at the present invention by considering the teachings of Kudo et al.

In addition, tables 1, 3, 4, 5, 6 and 8 of Kudo also disclose an alloy composition which does not overlap with the composition claimed in claim 13 of the present invention.

For example, Table 1 does not contain Nb and Zr, and the Fe-content is not within 12 to 16%. On the opposite, claim 13 discloses both, Nb and Zr and the Fe content is between 12.16 %.

Table 3 of Kudo does not contain Al or Zr, which are claimed in claim 13 of the present invention, and tables 4 and 5 of Kudo do not contain Nb or Zr. Table 6 of Kudo does not contain Zr, and Table 8 does not contain Al or Zr. Thus, Tables 1, 4-6 of Kudo teach alloys of different composition from the alloys claimed in claim 13 of the present invention. In addition, Applicants point out that the Fe-content varies within wide ranges in all the cited tables.

Since Kudo does not teach or disclose the claimed combination, and since a skilled artisan would not find a suggestion or a motivation in Kudo to modify Kudo's teaching to arrive at the presently claimed invention, the cited reference does not render

the presently claimed invention obvious under 35 U.S.C. 103(a). Therefore, claim 13, for the reasons set forth above is not rendered obvious by the prior art of record. Since claims 6-8 and 14-18 depend from claim 13, Applicants respectfully request that the rejection of all the claims under 35 U.S.C. 103(a) as being unpatentable over Kudo et al. be withdrawn.

In light of the foregoing amendments and arguments, the application is now believed to be in proper format for allowance of all claims and a notice to that effect is earnestly solicited.

Please deduct any fees resulting from this Amendment from deposit account number 16-2500 of the undersigned.

The undersigned attorney requests that the Examiner contact him at the telephone number indicated below if it would help expedite prosecution of this application.

Respectfully submitted,
PROSKAUER ROSE LLP
Attorney for Applicant(s)

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PROSKAUER ROSE LLP
1585 Broadway
New York, NY 10036-8299
Telephone: (212) 969-3000

By


Charles Guttmann
Reg. No. 29,161